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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,700	05/31/2000	Cary Lee Bates	ROC20000071	5217

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

8
DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,700

Applicant(s)

BATES ET AL.

Examiner

Young N Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-19,21,22,25-40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-19,21,22,25-40 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 10, 11, 12, 18, 27, 28, 29, 32, 35, and 38 have been amended and claims 43 and 44 have been cancelled.
2. Claims 1, 2, 4, 5, 8-19, 21, 22, 25-40 and 42 have been re-examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-2, 4, 5, 8-15, 17-19, 21, 22, 25-32, 34-36, and 38-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Adar et al. (US 6493702 B1).

Independent:

As per claims 1 and 18, Adar teaches a method (see title) and a computer-readable medium having instructions or programs (see abstract: "distributed program") which, when executed by a process cause the process to perform a method for managing bookmark information in a data structure residing on a computer, comprising: receiving a plurality bookmark information entries (see Fig.10 and col.10, lines 44), each of the bookmark information entries comprising a bookmarked network address and corresponding source identifier information identifying a specific source, of a plurality of sources, at which the bookmarked network address was bookmarked (see col.1, lines 27-39 & line 67 to col.2, line 4; col.2, lines 26-28; and col.8, lines 46-49); wherein each specific sources identified in the bookmark information entries is different one of the plurality of sources (inherent: see Fig.2, #212 & Fig.6, #614); and storing the bookmark information entries in the data structure (see col.4, lines 29-37 and col.5, lines 58-65).

As per claim 35, Adar teaches an apparatus, comprising: a computer (see col.1, line 15); a plurality of bookmarking device (see Fig.1, #110, #112, #114, & #116) each having a unique source identifier associated therewith (see col.1, line 67 to col.2, line 4; col.2, lines 26-28; and col.8, lines 46-49) and containing a browser adapted to process network addresses (see Fig.9, #912 and col.10, lines 13-18); and a network connection connecting the computer to the plurality of bookmarking devices (see Fig.1, #118),

wherein the plurality of bookmarking device transfers the respective selected ones of the bookmarked network addresses and the respective unique source identifiers to the computer via the network connection (see col.1, lines 27-39 & line 67 to col.2, line 4; col.2, lines 26-28; and col.8, lines 46-49) in a manner preserving an association between the selected ones of the respective bookmarked network addresses and the respective unique source identifier, whereby a user managing the bookmarked network addresses on the computer can identify their respective sources (see Fig.2-Fig.6; col.8, line 41 – col.9, line 20; and col.10, lines 47-53).

Dependent:

As per claims 2 and 19, Adar teaches of further comprising, collecting the network addresses and source identifier information during an Internet browsing session (see col.6, lines 1-3 and col.10, lines 32-47).

As per claims 4, 14, 15, 21, 31, and 38, Adar further teaches wherein the plurality of unique sources or source identifier information is selected from the group comprising of a laptop, a cellular phone, e-mail, a personal data assistant, a set-top box, a watch, a hand-held computer, a pager, and a desktop computer (see col.1, line 15).

As per claims 5, 9, 22, 26, and 40, Adar further teaches wherein the data structure is a bookmark table having at least one bookmark entry (see Fig.6, #614 and col.6, lines 3-8).

As per claims 8 and 25, Adar teaches of further comprising populating a plurality of fields with the bookmark information to form the at least one bookmark entry (see Fig.5 and col.8, lines 51-56).

As per claims 10 and 27, Adar teaches of further comprising, wherein the plurality of bookmark entries is received from a remote network source different from any of the plurality of sources (see Fig.1, #120 & Fig.9, #922).

As per claims 11, 12, 28, and 29, Adar teaches of further comprising, prior to receiving the bookmark information entries: browsing a network connected to the plurality of sources and comprising the network addresses (see col.1, line 49 to col.2, line 4 and col.3, lines 55-62); storing the network addresses as bookmarks (see Fig.9, #918; Fig.10, #1018; and col.10, lines 38-40 & 47-50) containing source identifier information identifying the corresponding specific resource performing the storing (see col.1, lines 27-39 & line 67 to col.2, line 4; col.2, lines 26-28; and col.8, lines 46-49); and sending stored bookmark addresses and corresponding source identifier information to the computer as bookmark information entries (see col.10, lines 50-53).

As per claims 13, 30, and 36, Adar further teaches wherein the network is the Internet, and the network addresses are Uniform Resource Locators (URLs) (see col.1, lines 27-33).

As per claims 17 and 34, Adar further teaches wherein the bookmark information received from the plurality of sources may be administered at a local computer based on the source identifier information (see abstract).

As per claim 32, Adar further teaches wherein each source is a different device (implicit: see col.1, lines 27-39) and wherein the source identifier information further identifies a context in which a corresponding network address was bookmarked on the

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respective specific source (see col.1, lines 27-39 & line 67 to col.2, line 4; col.2, lines 26-28; and col.8, lines 46-49).

As per claim 39, Adar further teaches wherein the computer comprises a data structure for storing the network addresses and unique source identifiers (see col.8, lines 46-49).

As per claim 42, Adar further teaches wherein the computer further comprises a second browser for managing the data structure (see Fig.2, Fig.3, Fig.5, and Fig.6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adar et al. (US 6493702 B1).

As per claims 16 and 33, Although Adar teaches of "other identifiers" (see col.8, lines 47-48), Adar does not explicitly teach wherein the source identifier information is selected from the group comprising of person, location, sender, channel, program, and phone number.

However these differences are only found in nonfunctional descriptive material and are not functionally involved in the steps recited. The selection of source or source identifier information would be performed regardless of the group type, so long as it the group has the ability to communicate via the Internet as taught by Adar. Thus these descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381,1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any group device because such devices does not functionally relate to the steps in the method claimed so long as they are able to communicate via the Internet and because the selection of a group type is subjective and thus does not patentably distinguish the claimed invention.

5. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adar et al. (US 6493702 B1) in view of Smethers (US 6560640 B2). Adar does not explicitly teach wherein the network connection comprises a wireless connection. Smethers teaches wherein the network connection comprises a wireless connection (see col.3, lines 64-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Smethers within the system of Adar by employing a wireless network communication within the bookmarking apparatus because Smethers teaches that the hypertext technology has spread to wireless communications (see col.1, lines 11-12).

Response to Arguments

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "source identifier that identifies... i.e., whether it was bookmarked on a lap top, computer, a cellular phone, ect.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). A source identifier is anything that which may identify a source, such as the username of the source, IP address or URL of the source, or even group that the source belongs to and not restricted to a device type. The claim language recites "source identifier information identifying a specific source", which implies that any information identifying a source can be applied as prior art. Clearly, as taught by Adar, interlinked collection of documents located on servers throughout the Internet possesses an address specifying the protocol, name of the computer or server, directory, and the file name where the data resides (see col.1, lines 27-39).

Additional reference locations have been provided to clarify any distinctions with respected to the claimed language. The applicant is reminded that it is the duty of the examiner to examined the claim language "given their broadest reasonable interpretation consistent with the specification" (see MPEP 2111). The specification does not recite that the source identifier identifies only the device type.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Young N Won



May 20, 2004



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER